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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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CESARI AND MCKENNA, LLP 88 BLACK FALCON AVENUE BOSTON, MA 02210			COSIMANO, EDWARD R	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/966,033	SMITH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Edward R. Cosimano	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 September 2001.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-47 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,5,6,8-10,12-27,31,34,37-39,41,44,46 and 47 is/are rejected.  
 7) Claim(s) 2,3,7,11,13,24,28-30,33,35,36,40,42,43 and 45 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 25 March 2002 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

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1. Applicant's claim for the benefit of an earlier filing date under 35 U.S.C. § 119(e) and 35 U.S.C. § 120 is acknowledged.
2. The proposed drawing correction filed 25 March 2002 has been approved.
3. The use of various trademark(s), for example: "WebRiposte™" have been noted in this application at paragraph located:

A) between page 12, line 24, and page 13, line 2, "The methods described herein are readily implemented using, e.g., conventional file servers and personal computers, although more powerful computers can, of course, be gainfully employed. The user database is readily prepared using conventional data-base software such as that supplied by Oracle, Microsoft and IBM, among others, or by software such as the Escher Group's WebRiposte™ for web-based applications. Communications between users of the system and the hardware components thereof may utilize any form of electronic communication, such as direct wire, wireless, modems, and the Internet, among others.".

Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

3.1 Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

4. The drawings are objected to because

A) the drawings must show every feature of the invention specified in the claims, therefore, the subject matter of:

- (1) claims 34, 39 & 44 in step (C);
- (2) claim 36 in regard to all of steps (i), (ii), (iii) & (iv);
- (3) claim 37 in regard to all of steps (i), (ii), (iii) & (vii);
- (4) claim 38 in regard to all of steps (a)-(d);
- (5) in regard to all of claim 41;
- (6) in regard to all of claim 46; and
- (7) in regard to claim 47, all of steps (a)-(c);

must be shown in the drawings as required by 37 CFR § 1.83(a) or the feature(s) canceled from the claim(s) (note: no new matter should be entered).

B) applicant must provide labels, which are clearly descriptive of the function performed by component represented by the depicted feature, for boxes 188 & 190 of fig. 10, as "printer/scanner" as described in the paragraph located at page 13, lines 3-15, "Figure 10 illustrates an environment in which the system of Figures 1-8 is advantageously used. A Post Office server 170 is connected via a network such as the Internet 172 to one or more postal stations 176, 178 and a number of remote terminals or nodes 174 that run or have access to web browsers that communicate with the server or client executables that communicate directly with the server or with the web browsers. For simplicity, only one such node is shown but it will be understood that that number of nodes to be used is potentially unlimited. Each postal station contains one or more work station nodes 180, 182 which may be interconnected by a network 184. The nodes provide access to the browsers and/or clients that communicate with the server. If desired, printer/scanners 186-190 may be attached to the workstation nodes to enable scanned input and hard-copy output at the nodes . Node 174 may be located in the home or office of an individual; nodes 180, 182 are located at the various postal service stations maintained by the Post Office, and are made available to individual users.", (37 CFR § 1.84(o)).

C) the following errors have been noted in the drawings:

(1) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(4) because:

(a) as can be seen in fig. 1, reference character "14" has been used to designate both "an area for entering a password" and in the paragraph located between page 5, line 23, and page 6, line 4, "The screen 10 contains an area 12 for entry of a user name and an area 14 for entry of a password. The name, which may be any sort of user ID, and the user password control access to the My Mail and the other services. The user ID may comprise, for example, the user's given name, an

identifier assigned by the system or the user's e-mail address. The password is preferably chosen by the user him or herself, since that access to the personalized services is controlled by the user. An address area 16 displays the address of the site on the web to which the user is connected, that is, the site that is providing the desired services. The site is, for example, initially accessed in the usual manner, i.e., by entering the web address in a browser and pressing "return" on a keyboard, or by clicking on a link to the web address that is presented, e.g., on a website of the postal service or on some sort of other video display. "Button" 15 enables the user to register at the website for the My Mail or other services provided through what is referred to herein as the "Postport System." Button 14 in conjunction with a selection of a service from a list 18 allows the user to access the selected service.".

(b) as can be seen in fig. 9 reference character "93" has been used to designate three separate features of the invention note the paragraph located at page 12, lines 3-23, As illustrated in Fig. 9, a company normally performs specific steps in designing and sending out mailings. Typically, a company chooses a mailing list (step 90), designs a mail piece (step 91), addresses and mails the mail piece to the entities on the list by delivering them to, for example, the postal service (steps 93, 95). As applicable, the company may check that the mail pieces are delivered by contacting the postal service or the intended recipients. To take advantage of the tracking capabilities of the Postport system, the company also designs a document, such as an XML document, or a web page that contains the contents of or selected information from the mail piece (step 92) and provides the document or web page URLs and the names on the mailing list in an uplink to the Postport system web site or server (step 94). The Postport system then uses the document and associated list to produce entries 32 for the tables 28 (Fig. 3) of the

respective users on the list, that is, to cross-link the table fields with the appropriate information based on the users' IDs. As discussed, the table entries also include related Postport system derived information such as associated delivery dates, current mail piece locations, delivery options, and so forth, as well as cross-links to associated on-line accounts, transaction histories and related information provided by the sender. Further, the document or the URLs may contain a link to a mechanism by which the intended recipient can respond electronically to any offers, such as subscriptions offers, included in the mail piece. The Postport system then links the table entries to the users' web pages and on request the system displays the appropriate entries as a table on a given user's web Page.”.

(2) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description, note:

(a) reference legend 22 as disclosed in the paragraph located at page 6, lines 7-15, “Fig. 2 depicts screen 20 to which a user is directed when button 15 of Fig. 1 is used to sign into the Postport system for the first time. Using the screen 20, a new user provides the requested address and identification information in order to register for the various Postport system services, and thus be assigned a Postport User ID. A user previously registered may be provided access to the screen 20 by selecting the My Profile service from the list 18 on the screen 10 of Fig. 1. Using the screen 20, the registered user may change its address, identification and/or password information. After registering or updating the registration information, the user selects one of the other services, for example, the My Mail service, using the menu bar 24.”.

(b) reference legend 44 as disclosed in the paragraph located between page 9, line 21, and page 10, line 2, “Referring now to Fig. 6,

a user may obtain a detailed view of a particular mail piece, for example, the City Electric bill, by highlighting the corresponding table entry 32 and clicking on the detail view listing in the sidebar 44. The system then displays a screen 70, which may include a copy or facsimile 72 of the corresponding mail piece and a list 74 of mail piece particulars, namely, sender, date sent, date received, and relevant information, such as the amount of the bill. The user has options, delineated by buttons 76, of paying the bill now from his or her on-line account, paying later from the account at a specified or unspecified date, or setting a payment policy such as directing that a certain portion of the bill be paid now and the remaining portion of the bill be paid after, for example, the deposit of a paycheck into the user's account. Through the buttons, the Postport system thus cross-links the mail piece information with the on-line account and payment information provided by, in the example, City Electric.”.

(c) reference legends 134d & 134e as disclosed in the paragraph located at page 10,lines 24-30, “The table 128 includes a field 134d that specifies the intended recipient. This information may be supplied directly by the user, supplied through a machine readable code on a pre-coded delivery label or, for electronic mailings, supplied by the user or by the intended recipient. The table also includes a field 134e for memos provided by the user and/or the postal service. The user may, for example, type a message into the system when the user is providing the mailing address information for a mailing label, or when he or she is making an electronic payment of a bill.”.

(d) reference legends 94 & 95 as disclosed in the paragraph located at page 12, lines 3-23, As illustrated in Fig. 9, a company normally performs specific steps in designing and sending out mailings. Typically, a company chooses a mailing list (step 90), designs a mail

piece (step 91), addresses and mails the mail piece to the entities on the list by delivering them to, for example, the postal service (steps 93, 95). As applicable, the company may check that the mail pieces are delivered by contacting the postal service or the intended recipients. To take advantage of the tracking capabilities of the Postport system, the company also designs a document, such as an XML document, or a web page that contains the contents of or selected information from the mail piece (step 92) and provides the document or web page URLs and the names on the mailing list in an uplink to the Postport system web site or server (step 94). The Postport system then uses the document and associated list to produce entries 32 for the tables 28 (Fig. 3) of the respective users on the list, that is, to cross-link the table fields with the appropriate information based on the users' Ids. As discussed, the table entries also include related Postport system derived information such as associated delivery dates, current mail piece locations, delivery options, and so forth, as well as cross-links to associated on-line accounts, transaction histories and related information provided by the sender. Further, the document or the URLs may contain a link to a mechanism by which the intended recipient can respond electronically to any offers, such as subscriptions offers, included in the mail piece. The Postport system then links the table entries to the users' web pages and on request the system displays the appropriate entries as a table on a given user's web Page.”.

(3) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description, note:

(a) reference legend 37d of fig. 3 as this figure is disclosed in the paragraph located at page 7, lines 19-26, “A type field 34b indicates to the user, again through the use of icons 37, the category of mail piece.

The mail piece may be a magazine as indicated by the icon 37a, a bill as indicated by the icon 37b, a letter as indicated by the icon 37c, a package as indicated by the icon 37d or a catalog as indicated by the icon 37e, and so forth as indicated by various other icons 37. A delivery field 34c informs the user of the actual or expected delivery date, while a sender field 34d informs the user of the source of the mail piece. An attachment field 34e displays an associated message that was supplied by the sender of the mail piece and/or the postal service or other delivery company.”.

(b) reference legend 50 of fig. 4 as this figure is disclosed in the paragraph located at page 9, lines 6-14, “Through information contained in or accessible from the sender field 34d, an entry 32 may be further associated with one or more links to a sender company URL, to various associated mail-piece specific information, and/or to mechanisms through which the user can respond electronically to offers included in the mail piece, such as, for example, subscription offers. The user clicks on the information displayed in the sender field and is either directly connected by the links to, for example, a particular URI, or, as discussed below with reference to Fig. 9, to other company information associated with the mail piece through the Postport system. Alternatively, as depicted in Fig. 4, the user may be presented with a pull-down menu 52 of the various links.”.

(4) as can be seen in fig. 9 and from the context of the paragraph located at page 12, lines 3-23, As illustrated in Fig. 9, a company normally performs specific steps in designing and sending out mailings. Typically, a company chooses a mailing list (step 90), designs a mail piece (step 91), addresses and mails the mail piece to the entities on the list by delivering them to, for example, the postal service (steps 93, 95). As applicable, the company may check that the mail pieces are delivered by contacting the postal service or the intended recipients. To take advantage of the tracking capabilities of the

Postport system, the company also designs a document, such as an XML document, or a web page that contains the contents of or selected information from the mail piece (step 92) and provides the document or web page URLs and the names on the mailing list in an uplink to the Postport system web site or server (step 94). The Postport system then uses the document and associated list to produce entries 32 for the tables 28 (Fig. 3) of the respective users on the list, that is, to cross-link the table fields with the appropriate information based on the users' IDs. As discussed, the table entries also include related Postport system derived information such as associated delivery dates, current mail piece locations, delivery options, and so forth, as well as cross-links to associated on-line accounts, transaction histories and related information provided by the sender. Further, the document or the URLs may contain a link to a mechanism by which the intended recipient can respond electronically to any offers, such as subscriptions offers, included in the mail piece. The Postport system then links the table entries to the users' web pages and on request the system displays the appropriate entries as a table on a given user's web Page.", in fig. 9 the feature of the invention that is:

- (a) indicated by reference number 93 and entitle "ENVELOPES DELIVERED" should be indicated by reference number -95--, and
- (b) indicated by reference number 93 and entitled "UPLOAD MAILING LIST AND URLs TO POSTPORT SITE" should be indicated by reference number -94--.

4.1 Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the

several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the continuing data in the paragraph located:

(a) at page 1, lines 2-6, "The present application claims priority from U.S. Provisional Patent Application Serial No. 60/236,976, filed on September 29, 2000, by Joshua R. Smith, et al. for ASSOCIATING ELECTRONIC DATA WITH PHYSICAL OBJECTS and U.S. Application No. 09/865,889, filed on May 25, 2001, by Joshua R. Smith et al. for ASSOCIATING ELECTRONIC DATA WITH PHYSICAL OBJECTS.";

(b) at page 5, lines 9-22, "The invention is explained by means of various screens. Fig. 1 depicts an introductory screen 10 of an exemplary graphical user interface that may be used in accordance with the present invention. The screen is displayed, e.g., on the video monitor of a computer connected to a computer network such as, but not limited to, the worldwide web. The screen summarizes the services that a user may access from the screen. In the present instance, five categories of services are provided, namely: My Mail, Virtual Post Office, Network Banking, Directory Services and My Profile. The personal tracking and tracing system described herein is provided under the My Mail category. While the other service categories may have various links to and from the information provided under the My Mail category, we do not otherwise discuss the other services. Certain of the service categories are

discussed in a co-pending United States Patent Application entitled METHOD AND APPARATUS FOR LINKING DATA AND OBJECTS and accorded Serial Number 09/865,889 which is assigned to a common assignee and incorporated herein in its entirety by reference.”;

where application 09/865,889 is abandoned;

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, --which is expired--, etc.

B) as required by 37 CFR § 1.84(p)(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) reference legend 37d of fig. 3 as this figure is disclosed in the paragraph located at page 7, lines 19-26, “A type field 34b indicates to the user, again through the use of icons 37, the category of mail piece. The mail piece may be a magazine as indicated by the icon 37a, a bill as indicated by the icon 37b, a letter as indicated by the icon 37c, a package as indicated by the icon 37d or a catalog as indicated by the icon 37e, and so forth as indicated by various other icons 37. A delivery field 34c informs the user of the actual or expected delivery date, while a sender field 34d informs the user of the source of the mail piece. An attachment field 34e displays an associated message that was supplied by the sender of the mail piece and/or the postal service or other delivery company.”; and

(b) reference legend 50 of fig. 4 as this figure is disclosed in the paragraph located at page 9, lines 6-14, “Through information contained in or accessible from the sender field 34d, an entry 32 may be further associated with one or more links to a sender company URL, to various associated mail-piece specific information, and/or to mechanisms through which the user can respond electronically to offers included in the mail

piece, such as, for example, subscription offers. The user clicks on the information displayed in the sender field and is either directly connected by the links to, for example, a particular URI, or, as discussed below with reference to Fig. 9, to other company information associated with the mail piece through the Postport system. Alternatively, as depicted in Fig. 4, the user may be presented with a pull-down menu 52 of the various links.”.

In this regard, it is noted that merely mentioning either a feature or a number without mentioning the device or operation or number or feature relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

C) the following errors have been noted in the specification:

(1) as can be seen in figs. 3, 6 & 7 and from the context of the paragraph located between page 9, line 21, and page 10, line 2, “Referring now to Fig. 6, a user may obtain a detailed view of a particular mail piece, for example, the City Electric bill, by highlighting the corresponding table entry 32 and clicking on the detail view listing in the sidebar 44. The system then displays a screen 70, which may include a copy or facsimile 72 of the corresponding mail piece and a list 74 of mail piece particulars, namely, sender, date sent, date received, and relevant information, such as the amount of the bill. The user has options, delineated by buttons 76, of paying the bill now from his or her on-line account, paying later from the account at a specified or unspecified date, or setting a payment policy such as directing that a certain portion of the bill be paid now and the remaining portion of the bill be paid after, for example, the deposit of a paycheck into the user's account. Through the buttons, the Postport system thus cross-links the mail piece information with the on-line account and payment information provided by, in the example, City Electric.”, the reference to reference number “44” should be -42--, so as to be consistent, note the

paragraph at page 7, lines 1-8, "Referring to Fig. 3 .. sidebar menu 42. The ... include a separate location field (not shown).".

(2) as can be seen in figs. 1 & 3-5, and the context of the paragraph located at page 10, lines 14-23, "Referring now to Fig. 7, the Postport system also provides personal tacking and tracing of mail pieces sent by the user. As depicted in screen 100, a table 128 includes entries 132 for the respective mail pieces that the user has sent. The user selects this table from a pull down menu (not shown) using arrow the 40 in menu bar 29. The Table includes status, type and delivery fields 134a, 134b and 134c that are similar to the fields of the table 28 discussed above with reference to Fig. 1. The information for these fields may be supplied by the postal service or other delivery company when the mail piece is provided to them by the user. In the case of electronic mailings, such as on-line payments, the information may instead be supplied by the company that is the intended recipient.", table 28 does not appear in "Fig. 1", hence the reference to fig. 1 in this paragraph should be -Fig. 3--.

D) the subject matter of:

- (1) claims 34, 39 & 44 in step (C);
- (2) claim 36 in regard to all of steps (i), (ii), (iii) & (iv);
- (3) claim 37 in regard to all of steps (i), (ii), (iii) & (vii);
- (4) claim 38 in regard to all of steps (a)-(d);
- (5) in regard to all of claim 41;
- (6) in regard to all of claim 46; and
- (7) in regard to claim 47, all of steps (a)-(c);

lacks antecedent basis within the specification as required by 37 CFR § 1.75(d1).

Appropriate correction is required.

6. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings.

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Applicant should note the requirements of 37 CFR § 1.52, 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

7. Claims 10, 18, 20-23, 25-26, 34, 37-39, 41, 44, 46 & 47 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7.1 In regard to claims 10, 18, 20-23 & 25-26, although one of ordinary skill at the time of the invention would know how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using the claimed invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

A) in regard to claim 10, and how the “information that identifies the senders” maybe associated with the “user identifiers”, since the invention as recited in this claim does not obtain or determine the “information that identifies the senders” and hence this information can not be associated.

B) in regard to claims 18, 20-23, and how either the “date on which delivery of a given mail piece is expected to occur” (claim 18); or the “source or a given mail piece” (claim 20); or the “contents of a given mail piece” (claim 21); or an “image of the contents of a given mail piece” (claims 22-23) may be displayed, since the invention as recited in this claim does not obtain or determine this information and hence this information can not be displayed.

C) in regard to claims 25-26, and how the links to information provided by the sender may be provided, since the invention as recited in this claim does not obtain or determine this information and hence this information can not be provided.

7.2 In regard to claim 37 and since this claim lists steps (i), (ii), (iii) & (vii) where and what are missing steps “iv”, “v” & “vi”.

7.3 The subject matter of:

A) claims 34, 39 & 44 in step (C);

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- B) claim 36 in regard to all of steps (i), (ii), (iii) & (iv);
- C) claim 37 in regard to all of steps (i), (ii), (iii) & (vii);
- D) claim 38 in regard to all of steps (a)-(d);
- E) in regard to all of claim 41;
- F) in regard to all of claim 46; and
- G) in regard to claim 47, all of steps (a)-(c);

lacks antecedent basis within the specification as required by 37 CFR § 1.75(d1).

7.4 For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

8. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

8.1 Claims 10, 18, 20-23 & 25-26 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

8.1.1 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), "We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory "process" within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." Cons. Art. 1, sec. 8.", {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 "14. A method of locating an

obstruction in an open channel to affect flow in a predetermined manner comprising:

- a) obtaining the dimensions of said obstruction which affect the parameters of flow;
- b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;
- c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter
- d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.”;

and “Concerning claims 14-39 and the significance of "post-solution activity," like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.”, {emphasis added}.

8.1.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the “specified adjusted location” in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims where not a

process with in the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non statutory subject matter.

8.1.3 As can be seen from claims 10, 18, 20-23 & 25-26, these claims are directed to a series of devices for performing various functions or steps/actions/functions, which as set forth above in regard to the rejection of claims 10, 18, 20-23 & 25-26 under 35 U.S.C. § 112 2<sup>nd</sup> paragraph, are not clearly and definitely interconnected to one another and therefore do not provide an operative useful machine/system or method/process with in the meaning of machine or process as used in 35 U.S.C. § 101.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9.1 Claims 1, 5, 6, 8, 9, 12, 14-19, 27, 31 & 32 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by the PRNewswire article: TanData™ Corporation Announces Progistics CS™, The newest, Internet-Enabled Shipping and Rating Software.

9.1.1 In regard to claims 1, 5, 6, 8, 9, 12, 14-19, 27, 31 & 32, the PRNewswire article discloses an internet based computer implemented tracking system in which an user enters an user identifier, e.g. a tracking number, at a client system using a web browser. The user entered information is then sent, via an internet connection, to a web server, where the server searches through data that has been collected from various points in the delivery stream as a item is being processed through the delivery stream, for recorded data entries that associate with the user identifier. Next all of the data entries related to the user's identifier are sent to the client system where the user may review the tracking data using a suitable user interface, for example a graphical user interface.

10. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) in regard to claims 2-4, 7, 25, 28-30, 32 the prior art does not teach or suggest including links to the message (claims 2, 28), or transaction information (claims

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3, 29), or contents of the message (claims 4, 30), or on-line offers (claims 7, 32), or information provided by the sender (claim 25) with in the tracking and status information.

B) in regard to claim 10, 11, the prior art does not teach or suggest including information regarding the sender (claim 10), or messages from the senders (claim 11) with in the tracking and status information. Claim 13 is allowable for the same reason.

C) in regard to claims 20-23, the prior art does not teach or suggest including information regarding the sender (claim 20), or the contents of the message (claim 21), or an image of the contents of the item (claims 22-23), or messages (claim 24), transaction information (claim 26) with in the tracking and status information.

D) in regard to claims 34, 39 & 44, the prior art does not teach or suggest using messages to permit a session to continue from the last point. Claims 35-38, 40-43 & 45-47 are allowable for the same reason.

11. The examiner has cited prior art of interest, for example:

A) Smith et al (WO 02/27618) or Bhadra (2002/0052794) or Smith et al (2002/0095306) or Karbowski et al(6,772,130) which disclose internet based tracking systems,

12. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783 (after 13 April 2005 (571) 272-6802). The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702 (after 13 April 2005 (571) 272-6812). Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

13.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

13.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

13.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

03/19/05

*Edward Cosimano*  
Edward R. Cosimano  
Primary Examiner A.U. 3629